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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,014	06/25/2001	Michael D. Crandall	54185USA8B.014	9951
32692	7590	07/30/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			ZIRKER, DANIEL R	
PO BOX 33427			ART UNIT	
ST. PAUL, MN 55133-3427			PAPER NUMBER	

1771

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE - 3 - MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 33 - 35 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 34, 35 is/are allowed.
- ☒ Claim(s) 33 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. Prosecution on the merits of this application is reopened on claim 33 considered unpatentable for the reasons indicated below: Note particularly the obviousness type double patenting rejection set forth below.

2. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent.

*In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73 (b).

3. Claim 33 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the combination of claims 1, 2, and 4 of U.S. Patent No. 6,296,932B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because it appears that the broader claim 33 should have been rejected over a combination of the narrower claims 1, 2, and 4 set forth in the 932 parent continuation application for the

following reasons. Note that there are several differences in the language of claim 33 from that found in the patent claims, which the Examiner will try to list below, such as the fact that claim 1 in line 5 recites that the microspheres "are the reaction product" whereas such language is missing in claim 33, and that the patent recites that the adhesive contains 1-10% by weight of an "aqueous polyacrylamide material" whereas "comprising" claim 33 recites only the presence of an unspecified amount of "polyacrylamide"; these differences are considered to be non-obvious in view of each other. In a similar vein claim 1 of the patent recites the presence of an alkyl(meth)acrylate ester wherein the acryl group contains 4 to about 14 carbon atoms, whereas this numeric carbon atom limitation is absent from the pending claim 33, and also the fact that the patent recites the presence of a four membered Markush group wherein a "polar comonomer" is one of the members which is individually specifically set forth in lines 9-10 of claim 33. Additionally, note that the 90° peel value parameter found in claim 33 is specifically set forth in dependent claim 2 and also the limitation as set forth in claim 33 that "a majority of the microspheres containing at least one interior void having a diameter at least 10% of the diameter of the hollow microspheres" is found in dependent claim 4 of the patent. Accordingly, upon

further review it is the position of the Examiner that claim 33 of the recently allowed application Serial No. 09/891,014 is obvious in view of claims 1, 2, and 4 of the claims set forth in its parent continuation case as set forth above.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Serial No. 09/891,014

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Dzirker:cdc

June 9, 2004

DANIEL ZIRKER  
PRIMARY EXAMINER  
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1700

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